

ESTTA Tracking number: **ESTTA401195**

Filing date: **04/01/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|---|
| Proceeding | 91195460 |
| Party | Plaintiff Roche Therapeutics Inc. |
| Correspondence Address | ELIZABETH ATKINS LATHROP & GAGE LLP 230 PARK AVENUE, SUITE 1847 NEW YORK, NY 10169 UNITED STATES tfitzgerald@lathropgage.com |
| Submission | Motion to Extend |
| Filer's Name | Thomas J. FitzGerald |
| Filer's e-mail | tfitzgerald@lathropgage.com, eatkins@lathropgage.com |
| Signature | /thomas j. fitzgerald/ |
| Date | 04/01/2011 |
| Attachments | Registrant's Motion for Extension of All Dates.pdf (19 pages)(4245614 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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|-------------------------------|---|-----------------------|
| -----X | | |
| Roche Therapeutics Inc., | : | |
| | : | |
| Opposer, | : | Opp. No. 91195460 |
| | : | |
| v. | : | Serial No. 77/744,250 |
| | : | |
| Daiichi Sankyo Company, Ltd., | : | |
| | : | |
| Applicant. | : | |
| -----X | | |

**REGISTRANT'S MOTION FOR EXTENSION
OF ALL DATES IN THE PROCEEDING**

Registrant, by its undersigned attorneys, hereby moves, pursuant to Federal Rule of Civil Procedure 6(b) and Trademark Rule 2.120(a), for an order extending all dates in the proceeding by 90 days, and respectfully shows the following.

RELEVANT FACTS

1. Registrant filed the Notice of Opposition in this case on June 28, 2010 and the Trademark Trial and Appeal Board ("the Board") set all dates in the proceeding pursuant to its Notice of the same date.

2. The Board first set the date of March 5, 2011 for the close of discovery in its Notice of June 28, 2010.

3. By stipulation between counsel for Registrant and counsel for Applicant, dated September 1, 2010, all dates in the present proceeding were extended by 30 days so that discovery is presently set to close on April 4, 2011.

4. In Registrant's diligent attention to Applicant's written discovery requests, Registrant noted a number of typographical errors as well as inadvertent transpositions of

the terms "Applicant" and "Opposer" among Applicant's written discovery which would have rendered some of Applicant's written requests for the production of documents and things and interrogatories ineffective. Registrant, in the spirit of comity, alerted Applicant's counsel by telephone on December 21, 2010 to these typographical errors as well as by letter of December 21, 2010 rather than simply responding to Applicant's written discovery as drafted, which would have been unproductive for both parties. A copy of Registrant's letter detailing these issues is attached as Exhibit A.

5. On December 22, 2010, counsel for Applicant informally served by e-mail amendments to a certain number of interrogatories and document requests. A copy of the letter informally serving Applicant's amended discovery is attached as Exhibit B.

6. One of the document requests that Applicant amended was document request number 21 which read as follows as originally served:

21. *All documents and tangible things relating to applicants [sic] claim that Opposer's marks are famous under Section 43 c) [sic] of the Federal Trademark Act.*

Applicant's amended document request number 21 read as follows:

21. *All documents and tangible things relating to Opposer's claim that Opposer's marks are famous under Section 43 c) [sic] of the Federal Trademark Act.*

7. In addition to these changes to Applicant's document requests, other of Applicant's documents requests are drafted in such a way that the production of huge volumes of documents is required to respond to the requests. In particular, Registrant notes the following document requests:

7. *All of Opposer's advertising materials which references [sic] to Opposer's marks.*

9. *All samples of all goods sold or distributed under Opposer's*

marks.

10. *All samples of all promotional materials and sales materials utilizing Opposer's marks that have been distributed in the United States.*

8. To date, Registrant has reviewed tens of thousands of documents and has already produced more than 5,000 documents and things responsive to Applicant's document requests and Registrant has also provided verified responses to Applicant's Amended Interrogatories.

9. Applicant's responses to Registrant's written discovery are not presently due until *after* the close of discovery based on agreements reached between counsel for the granting of extensions of time for Registrant to respond to Applicant's written and amended discovery.

10. Registrant has requested consent to extend all dates in the proceeding by 90 days on three occasions, but Applicant's counsel has not provided consent for the extension of all dates. Counsel for Registrant's letters dated February 16, February 23 and March 16 are attached as Exhibits C, D, and E, respectively.

ARGUMENT

I. Registrant Is Not Guilty of Negligence or Bad Faith

The Board has held that the appropriate standard for allowing an extension of a prescribed period prior to the expiration of a time period is "good cause." Fed. R. Civ. P. 6(b); TBMP § 509. The board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. American Vitamin Products, Inc. v. DowBrands Inc., 22 U.S.P.Q.2d 1313 (TTAB 1992).

Registrant has been diligent in responding to Applicant's written discovery requests, having served as of this filing more than 5,000 documents and things as well as verified responses to Applicant's interrogatories. Much of Registrant's efforts in responding to Applicant's discovery requests has been due to Applicant's revised document requests sent by email by counsel for Applicant on December 22, 2010, just days before key employees and representatives of Registrant were first on an extended holiday leave and then out of the office attending to mandatory business in their professional capacities. Additionally, the hugely broad document requests also noted herein are the subject of a great deal of time and ongoing effort on the part of Registrant and Registrant's counsel to properly and fully address.

Applicant's informal changes to its requests, which have not been served under the Federal Rules of Federal Procedure or the Trademark Rules of Practice, changed interrogatory 21 from requesting documentation of fame of "applicants [sic] marks" to documentation of fame of "Opposer's marks". Applicant's proposed name is merely the subject of an intent-to-use application and is not presently in use in connection with any goods and/or services, to the knowledge of Registrant, so Registrant did not plan to produce any information in response to this area of Applicant's original discovery as there could be no such information or documents in Registrant's custody or control. When Registrant received Applicant's informal revisions to its discovery requests, Registrant began diligently to gather the vast amount of additional information that would need to be culled from Registrant's records in various formats in response to Applicant's exceedingly broad requests. As Registrant's marks have been in use for many years and are the subject of enormous national advertising campaigns featuring the Oscar[®]-winning actress

Sally Field, as well as massive print advertising campaigns in major periodicals, gathering the information requested by Applicant, as broadly as it is drafted, has required incredible efforts of key employees and representatives of Registrant. Nevertheless, Registrant has been working diligently and respectfully submits that a 90-day extension of all dates to complete production of all documents and things could not be harmful in any way to Applicant. In fact, it will ensure that Applicant receives the most thorough responses to its written discovery possible.

Registrant has not acted in bad faith, but has affirmatively tried to foster comity in the proceeding by affirmatively notifying counsel for Applicant of errors in its discovery requests so that both parties may move the proceeding along in a meaningful way. Registrant submits that the facts speak for themselves that Registrant has been neither negligent in any way nor has Registrant abused any requests for extensions of time, as this request, if granted, would be only the second extension of all dates in the proceeding, and the first such request was for only 30 days and was on consent of Applicant.

II. Fairness Suggests an Extension of All Dates is Proper in this Case

The present schedule of the proceeding would have Applicant's deadline for serving responses to Registrant's written discovery *after* the close of discovery. Though serving responses to written discovery after the close of discovery is permitted under Trademark Rules of Practice, Registrant submits that it would be materially prejudiced by this schedule as Registrant would not be able then to take discovery depositions or to serve potentially vital additional written discovery. Under 37 CFR § 2.120(a) "Discovery depositions must be taken,...on or before the closing date of the discovery period." Therefore Registrant has had no opportunity to notice any depositions Applicant and has

had no opportunity to take a discovery deposition since Applicant has yet to produce a single document of any kind or respond to a single interrogatory.

Applicant has had the benefit of many weeks to review all of the documents produced thus far in response to Applicant's amended discovery as well as Registrant's verified responses to Applicant's interrogatories. Registrant has yet to see a single document or review a single verified response by Applicant. Registrant acknowledges that an element of this result is due to the extensions Registrant needed to respond to Applicant's discovery, but as discussed herein, it was Applicant's own errors and Registrant's good faith attempt to resolve those errors in a productive fashion, rather than remaining quiet and responding ineffectively to Applicant's discovery requests that has led directly to this result. Registrant should not be penalized for trying to resolve such issues in the spirit of comity; and neither should Applicant be permitted to thus avail itself of some perceived tactical advantage by "running out the clock" on discovery. Such a result is surely outside the bounds of fairness.

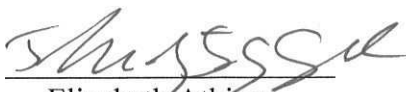
CONCLUSION

Registrant has not acted in bad faith and has not abused, nor seeks here to abuse, the grant of extensions of time. Further, the proceeding schedule as presently set will result in material prejudice to Registrant. Registrant, therefore, respectfully requests that the Board extend all dates in the proceeding by 90 days.

Respectfully submitted,

LATHROP & GAGE LLP

Dated: April 1, 2011
New York, New York

By: 
Elizabeth Atkins
Thomas H. Curtin
Thomas J. FitzGerald

230 Park Avenue, Suite 2400
New York, New York 10169
(212) 850-6220 (tel)
(212) 850-6221 (fax)

Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the present MOTION FOR EXTENSION OF TIME was filed electronically with the Trademark Trial and Appeal Board on April 1, 2011.


Thomas J. FitzGerald

CERTIFICATE OF SERVICE

I hereby certify that a copy of the present MOTION FOR EXTENSION OF TIME was sent via U.S. mail, return receipt requested, postage prepaid, to the following address on April 1, 2011, such being the address of the Applicant's counsel:

KAUSHAL R. ODEDRA
ODEDRA LAW OFFICE, PLLC
15799 Spyglass Hill Loop
Gainsville, VA 20155

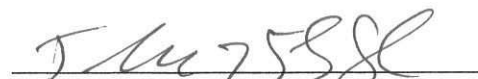

Thomas J. FitzGerald

EXHIBIT A

Fitzgerald, Thomas J.

From: Fitzgerald, Thomas J.
Sent: Tuesday, December 21, 2010 9:05 PM
To: 'kodedra@odedralaw.com'
Subject: Re: 77/744,250 BENIVAS opposition
Mr. Odedra,

The specific issue with the three document requests (20, 21 and 22) and interrogatories (27, 36 and 37, if I recall accurately) is that they refer to "applicant's claims of the fame of Opposer's mark" and other such information related to "applicant's claims" where applicant has made no such claims. I think these are simple transposition issues where it should be "opposer's claims..."

Please let me know your comments. If no amendments are necessary, also please advise, as there clearly will be very few, if any, documents responsive to these requests and interrogatories.

Many thanks.

Thomas J. FitzGerald

From: Kaushal Odedra <kodedra@odedralaw.com>
To: Fitzgerald, Thomas J.
Sent: Tue Dec 21 19:40:58 2010
Subject: Re: 77/744,250 BENIVAS opposition

Dear Mr. Fitzgerald,

Concerning your voice mail today, please clarify the issues you see with the specific discovery requests.

Sincerely,

Kaushal Odedra, Esq.

KOdedra@OdedraLaw.com

EXHIBIT B

Fitzgerald, Thomas J.

From: Kaushal Odedra [kodedra@odedralaw.com]
Sent: Wednesday, December 22, 2010 7:58 PM
To: Fitzgerald, Thomas J.
Subject: Re: 77/744,250 BENIVAS opposition
Attachments: 77744250 12-22-10 amended BENIVAS Applicant's First Set of Doc Request Nos 21 and 22.pdf;
77744250 12-22-10 amended BENIVAS applicant's first set of Interr No. 27 36 and 37.pdf

Dear Mr. Fitzgerald,

Thank you for your email.

Our Interrogatory No. 35 and Doc Request No. 23 would clarify any issues and therefore amendment of our requests are not necessary. However per your request attached is an amended page for Interrogatory Nos. 27, 36 & 37 and an amended page for Doc Request No. Nos. 21 & 22. Doc request 20 is not changed since it would repeat 19. The due dates remain the same for our requests.

Please confirm if this acceptable.

Sincerely,

Kaushal Odedra, Esq.

KOdedra@OdedraLaw.com

ODEDRA LAW OFFICE, PLLC

From: "Fitzgerald, Thomas J." <TFitzgerald@LathropGage.com>
To: kodedra@odedralaw.com
Sent: Tue, December 21, 2010 9:04:42 PM
Subject: Re: 77/744,250 BENIVAS opposition

Mr. Odedra,

The specific issue with the three document requests (20, 21 and 22) and interrogatories (27, 36 and 37, if I recall accurately) is that they refer to "applicant's claims of the fame of Opposer's mark" and other such information related to "applicant's claims" where applicant has made no such claims. I think these are simple transposition issues where it should be "opposer's claims...".

Please let me know your comments. If no amendments are necessary, also please advise, as there clearly will be very few, if any, documents responsive to these requests and interrogatories.

Many thanks.

Thomas J. FitzGerald

4/1/2011

This e-mail (including any attachments) may contain material that (1) is confidential and for the sole use of the intended recipient, and (2) may be protected by the attorney-client privilege, attorney work product doctrine or other legal rules. Any review, reliance or distribution by others or forwarding without express permission is strictly prohibited. If you are not the intended recipient, please contact the sender and delete all copies.

From: Kaushal Odedra <kodedra@odedralaw.com>
To: Fitzgerald, Thomas J.
Sent: Tue Dec 21 19:40:58 2010
Subject: Re: 77/744,250 BENIVAS opposition

Dear Mr. Fitzgerald,

Concerning your voice mail today, please clarify the issues you see with the specific discovery requests.

Sincerely,

Kaushal Odedra, Esq.

KOdedra@OdedraLaw.com

EXHIBIT C

Fitzgerald, Thomas J.

From: Fitzgerald, Thomas J.
Sent: Wednesday, February 16, 2011 4:09 PM
To: Kaushal Odedra
Subject: RE: 77/744,250 BENIVAS opposition
Dear Mr. Odedra,

Responses by Opposer to Applicant's Outstanding Discovery

We have received your letter below, and further to your comments, we plan to serve responses to Applicant's Interrogatories and Requests for Documents and Things served October 15 and amended December 22, 2010 within the current deadline. The current deadline for serving Opposer's responses is February 19, a Saturday, and the following Monday, February 21 is a federal holiday, so responses are due by February 22. There is a chance that due to the federal holiday there will be some delay in service of responses by a few days, but responses will be served no later than Friday, February 25. Due to this holiday, we trust that you have no objection to a possible very short delay, with service being made within the week that responses are presently due.

Responses by Applicant to Opposer's Outstanding Discovery

April 10 (a Sunday) is the date responses to Opposer's discovery requests are due under our agreement of November 16, 2010, so Applicant's responses to Opposer's outstanding written discovery are due to be served on April 11, 2011. Opposer will consent to extend this date by the same number of days past February 22 that Opposer's responses are served, if any.

Proceeding Schedule

The present schedule for the proceeding has expert disclosures scheduled for March 3, 2011 and close of discovery on April 4, 2011. Therefore we are writing for your consent to extend all dates in the proceeding by 90 days (experts 6/3/11; discovery 7/3/11), which will allow for any additional written discovery and discovery depositions. As you will note, the current schedule would have responses to Opposer's outstanding written discovery potentially served *after* close of discovery, which would substantially prejudice Opposer in the proceeding. We look forward to your response on the above, and to Applicant's consent to extend all dates by 90 days for the practical reasons delineated above.

Sincerely,

Thomas J. Fitzgerald
Lathrop & Gage LLP
230 Park Avenue
Suite 2400
New York, NY 10169
tel (212) 850-6230
fax (212) 850-6221
lathropage.com

From: Kaushal Odedra [mailto:kodedra@odedralaw.com]
Sent: Sunday, February 13, 2011 6:24 PM
To: Fitzgerald, Thomas J.
Subject: 77/744,250 BENIVAS opposition

4/1/2011

Dear Mr. Fitzgerald,

I received your voice mail requesting another extension. Since we have been very reasonable and consented to multiple extensions already, we will expect responses under the current deadline with no extension.

Sincerely,

Kaushal Odedra, Esq.

KOdedra@OdedraLaw.com

ODEDRA LAW OFFICE, PLLC
2020 Pennsylvania Ave, NW #152
Washington DC, 20006
Phone:202-595-2270
Fax:202-403-3777

4/1/2011

EXHIBIT D

Fitzgerald, Thomas J.

From: Fitzgerald, Thomas J.

Sent: Wednesday, February 23, 2011 4:11 PM

To: 'Kaushal Odedra'

Subject: Opposition No. 91195460 - Registrant's February 16, 2011 Request for Extension of All Dates

Dear Mr. Odedra,

We await Applicant's response to Registrant's request of February 16, 2011 for consent to an extension of all dates in the proceeding by 90 days, which will have expert disclosures by June 3, 2011 and the close of discovery on July 3, 2011. As Registrant's request has been outstanding now for a week and the expert witness deadline is March 3, 2011, Applicant's response by close of business Monday, February 28, 2011 would be appreciated.

Best regards,

Thomas J. FitzGerald
Lathrop & Gage LLP
230 Park Avenue
Suite 2400
New York, NY 10169
tel (212) 850-6230
fax (212) 850-6221
lathropgage.com

4/1/2011

EXHIBIT E

Fitzgerald, Thomas J.

From: Fitzgerald, Thomas J.
Sent: Wednesday, March 16, 2011 3:33 PM
To: Kaushal Odedra
Cc: Atkins, Elizabeth
Subject: Opposition No. 91195460 - Roche Therapeutics Inc. v. Daiichi Sankyo Company, Ltd.
Attachments: Opposer's Supplemental Responses to Applicant's Amended First Set of I-Rogs.pdf; RE: 771744,250 BENIVAS opposition; Opposition No. 91195460 - Registrant's February 16, 2011 Request for Extension of All Dates

Mr. Odedra,

Courtesy Copy of Supplemental Responses

Attached is a courtesy copy of Opposer's Supplemental Responses to Applicant's Amended First Set of Interrogatories which were served today.

3rd Request for Consent to Extension of All Dates

We have been waiting now for a month for a response to the attached request dated February 16 for consent to an extension of all dates in the proceeding under the heading "Proceeding Schedule". We wrote again on February 23 (attached) clearly explaining the nature of the consent we sought, but have yet to receive a response to this request. We note your letters of February 17 and 24 appear to us to address only our request for a 5 business day extension of time to respond to Applicant's amended discovery requests. Those letters do not appear to address our request for an extension of all dates. If the two are somehow related, then I am at a loss to see how.

Regardless of past requests, considering 1) you now have full verified responses to all of Applicant's amended interrogatories as well as thousands of documents responsive to Applicant's document requests and interrogatories and 2) Applicant's responses to Opposer's initial discovery requests are not due until well after the present discovery cutoff, we must now request, as stated in our letters of February 16 and February 23 that you advise us of whether you will consent to a 90-day extension of all dates. Your reply by Friday, March 18, 2011 is requested. Your cooperation is appreciated.

Best regards,

Thomas J. Fitzgerald
Lathrop & Gage LLP
230 Park Avenue
Suite 2400
New York, NY 10169
tel (212) 850-6230
fax (212) 850-6221
lathropgage.com

4/1/2011